



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/642,452   | 08/15/2003  | John E. Adams        | NAC-450             | 1602             |
| 22832  | 7590        | 08/15/2005           | EXAMINER            |                  |
| KIRKPATRICK & LOCKHART NICHOLSON GRAHAM LLP<br>(FORMERLY KIRKPATRICK & LOCKHART LLP) |             |                      | AHMAD, NASSER       |                  |
| 75 STATE STREET  |             |                      | ART UNIT            | PAPER NUMBER     |
| BOSTON, MA 02109-1808  |             |                      | 1772                |                  |
| DATE MAILED: 08/15/2005  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                          |                     |  |
|------------------------------|--------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b>   | <b>Applicant(s)</b> |  |
|                              | 10/642,452               | ADAMS ET AL.        |  |
|                              | Examiner<br>Nasser Ahmad | Art Unit<br>1772    |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 July 2005.  
 2a) This action is FINAL.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-17 is/are pending in the application.  
 4a) Of the above claim(s) 1-9, 16 and 17 is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_\_ is/are allowed.  
 6) Claim(s) 10-15 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
     1. Certified copies of the priority documents have been received.  
     2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
     3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
     Paper No(s)/Mail Date 9/13/04, 1/20/04.

4) Interview Summary (PTO-413)  
     Paper No(s)/Mail Date. \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election with traverse of Group II in the reply filed on July 5, 2005 is acknowledged. In the absence of any ground(s) of traversal by the applicant, the requirement is still deemed proper and is therefore made FINAL.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 10, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Schuller (2005/0055637).

Schuller relates to a method of making a label comprising the steps of providing a substrate (114) having a front side and a back side, the back side comprising an adhesive (124), deadening (126) a first portion (under the ink print layer) of the adhesive back side, applying ink (128) to the deadened first portion, contacting the back side with a release liner (132) applying ink (120 or 122) to the front side of the substrate, and forming a label having a back side with a deadened first portion, and a second and a

third portion are located proximate the first portion as shown by the areas of that are not provided with prints.

The ink defines printed information and the ink on the front surface is colored because the print is visible.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 11-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schuller in view of Korondi (5702127).

Schuller, as discussed above, fails to teach that the deadening step comprises applying UV-curable solution to the adhesive and curing the solution. Korondi discloses a method of making a label comprises providing a label having two lines of perforations that divides the label sheet into first, second and third portions, providing the first center portion with an UV-curable deadening solution and curing the solution using UV-source (abstract; col.3, line 66 to col. Line 7). Therefore, it would have been obvious to one having ordinary skill in the art to utilize Korondi's teaching or using UV-curable deaden solution for deadening a first portion of the label back side in the invention of Schuller with the motivation to render said first portion non-tacky and separable from the adhesive portions of the label.

Further, Schuller, in paragraph-[0032], teaches that the labels are formed by cutting the substrate into multiple labels without cutting the liner.

Schuller, as discussed above, also shows that the label is separated into two portions by a perforation line, but fails to teach the presence of a third portion. It would have been obvious to provide a third portion proximate the deadened first portion because it would have been duplication of the second portion, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. St. Regis Paper co. v. Bemis Co., 193 USPQ 8. Thus, the presence of the third portion would provide for additional region for information of the label front side.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nasser Ahmad whose telephone number is 571-272-1487. The examiner can normally be reached on 7:30 AM to 5:00 PM, and on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Nasser Ahmad*  
Nasser Ahmad 8/8/05  
Primary Examiner  
Art Unit 1772

N. Ahmad.  
August 8, 2005.